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EXAMINER

METZMAIER, DANIEL S

ART UNIT

PAPER NUMBER

1712

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14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/763,085

Applicant(s)

BARA, ISABELLE

Examiner

Daniel S. Metzmaier

Art Unit

1712

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 7/14; 4/30; 8/27; 9/28/2001; 10/15/2002.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 27-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8                      6) ☐ Other: \_\_\_\_\_

Art Unit: 1712

**DETAILED ACTION**

Claims 27-83 are pending. The PCT/DO/EO/905 form has been entered as Paper No. 2. The declaration filed March 2, 2001 has been entered as Paper No. 3. The PCT/DO/EO/903 form has been entered as Paper No. 4. The letter of notification has been entered as Paper No. 5. The corrected PCT/DO/EO/903 form has been entered as Paper No. 6. The priority Papers filed July 14, 2000 has been entered as Paper No. 7. The Information Disclosure Statement filed April 30, 2001 has been entered as Paper No. 8. Claims 1-26 have been canceled and new claims 27-83 added by the preliminary amendment filed April 30, 2001, Paper No. 9. Claims 43 and 44 have been amended in the preliminary amendment filed August 27, 2001, Paper No. 10. Claims 43 and 44 have been amended in the preliminary amendment filed September 28, 2001, Paper No. 11. Applicants' election and amendment of claim 82 filed October 15, 2002 has been entered as Paper no. 13.

***Election/Restrictions***

1. Applicant's election with traverse of the invention of Group I, the gellan species in Paper No. 13 is acknowledged. The traversal is on the ground(s) that the lack of unity practice requires unity to exist between the (1) method of manufacture, (2) the product and (3) the method of using said product. This is not found persuasive because the requirement set forth in PCT Rule 13.2 has not been met and therefore the groups cannot be concluded to have the same technical features.

The restriction has been collapsed but the election of species remains in effect. All the claims are generic to the elected species.

Art Unit: 1712

The requirement is still deemed proper and is therefore made FINAL.

***Priority***

2. Receipt is acknowledged of papers received in this national stage application from the International Bureau (PCT Rule 17.2(a)), submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim interpretation***

3. Several of the claims limit the species in a genus while not limiting the genus to said species. The remaining claim is generic to the remaining species. An example exist in claim 29, wherein the synthetic and semisynthetic gels of polyesters are limited but not defined as the hydrophilic gelling agent. The claims have been examined to the extent they read on the elected species.

The term solid and gel have been defined at page 7, lines 6-17. The particular gel strength is considered a physical property of gel compositions, which is often not characterized. It is noted the Office does not make experimental determinations. Attention is further directed to MPEP 2112.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 27-83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1712

In claim 27 applicants set forth components (i), (ii), and (iii) wherein the combination of (i) and (ii) are present in an amount of up to 20% by weight. Since "up to" reads on zero, it is unclear what is the scope of the claim. See MPEP 2173.05(c). The open ended range makes it unclear whether the components (i) and/or (ii) are required or may be construed as optional components.

Several of the claims contain improper alternative groupings that should be corrected. Attention is directed to MPEP 2173.05(h). An example may be found in claim 28 where the grouping does not use closed language and employs "and" several times. Said grouping is indefinite as to the scope of its members and the grouping. It is suggested applicants insert - - the group consisting of - - after chosen from and amend the groups to remove multiple use of "and".

Several of the claims employ the species as derivatives but fail to define how said materials are derived or what said derivatives consist. It is unclear what are the scope of the derivatives contemplated. See claim 28 wherein applicants set forth the limitations of "protein derivatives" and "derivatives thereof". It is further unclear what is the scope of a "derivative of" a "protein derivative". Other examples may be found in claim 35.

In claims 47, 51 and 60; it is unclear the phase of claim 41 is required since the limitation "up to 40% by weight" reads on zero. At a minimum the claims may be construed to read on the respective pigments, nacreous substances and fillers in claims 47, 51 and 60 as optional when the other pulverulent materials are present. See also claim 71.

Art Unit: 1712

In claims 54 and 55, "the metallic soaps lacks antecedent basis.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 27-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/17055<sup>1</sup> to L'Oreal, as evidenced by patent family member document Roulier et al US 6,045,814 (hereafter Roulier et al '814), taken with Roulier et al, US 6,280,750 (hereafter Roulier et al '750).

Roulier et al '814 is an English language patent family member of WO 97/17055. Attention is directed to the Roulier et al '814 patent face items [86], [87], and [30]. WO 97/17055 was published May 15, 1997 and the date qualifies as prior art under 35 USC 102(b). The disclosures are expected to be the same or substantially the same. The Roulier et al '814 reference is referred to hereafter.

Applicants define their solid gels at page 6, lines 6-17. The gels in the Roulier et al '814 reference are defined at column 1, lines 19-29, wherein the gels of the Roulier et al '814 reference and those instantly claimed at least overlap in the gel strength. Furthermore, the gel strength is directly proportional to the concentration of the gelling agent in the gel, *i.e.*, an increase in gelling agent generally increases the gel strength.

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<sup>1</sup> WO 97/17055, FR 2740,678, and US 6,045,814 are all believed to belong to the same patent family.

Art Unit: 1712

Roulier et al '814 (column 3, lines 15 et seq, particularly lines 24-29) discloses the use of cellulose derivatives as hydrophilic gelling agents. Roulier et al '814 (column 3, lines 13-14, and the claims) set forth one or more hydrophilic gelling agents.

Roulier et al '814 (column 4, lines 44 et seq, particularly 60 et seq, and examples) discloses pigments and pearlescing pigments that read on the claimed pulverulent phase.

Roulier et al '814 differs in the concentration of said gelling agents in the solid gels and the combination of gelling agents taught in the prior art for said same purpose as gelling agents.

Roulier et al '814 exemplifies the use of a seed extract including carob gum. Roulier et al '814 (column 3, lines 15-40) teaches numerous gelling agents that may be employed including alga extracts including carrageenans and alginates; seed extracts including carob gum; and microorganism exudates including xanthan and cellulose carboxymethyl-, hydroxyalkyl- and alkyl-substituted derivatives among other gelling agents. Roulier et al '814 (abstract ; column 3, lines 41 et seq; and claims) disclose the gelling agent concentration ranges from 20% by weight to 80% by weight or at least 20% by weight rather than the less than 20% by weight instantly claimed.

Roulier et al '814 (column 7, lines 57 et seq) discloses a number of pigments and pearlescing agents including organic dyes and inorganic pigments in concentrations of 2 to 30 % by weight.

Roulier et al '750 (abstract ; column 2, lines 24-33; column 2, line 52 to column 3, line 8 ; examples and claims) discloses solid gel compositions employing a combination

Art Unit: 1712

of gellan gum and at least one other hydrocolloid including cellulose derivatives.

Roulier et al '750 (column 2, lines 24-33) discloses the gel strength of the said gels.

Roulier et al '750 (column 2, lines 52 et seq) discloses the concentrations of the gelling agents wherein the preferred concentrations of the combination reads on the claimed concentration.

These references are combinable because they teach cosmetic gels. It would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ gellan gum in combination with a cellulose derivative as taught in the Roulier et al '750 reference as an obvious gelling agent contemplated in the Roulier et al '814 compositions at concentrations of less than 20 % by weight to form the gels taught in the Roulier et al '814 reference.

Furthermore, it would have been obvious to one of ordinary skilled in the art at the time of applicants' invention to employ the pulverulent phase disclosed in the Roulier et al '814 reference as an obvious powder phase components conventionally use in cosmetics.

Furthermore, it is generally prima facie obvious to use in combination two or more ingredients that have previously been used separately for the same purpose in order to form a third composition useful for that same purpose. In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980); In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971); In re Crockett, 279 F.2d 274, 126 USPQ 186 (CCPA 1960). As stated in Kerkhoven and Crockett, the idea of combining them flows logically from their having been individually taught in the



Art Unit: 1712

prior art. In the instant case, both the cellulose derivatives and the gellan gums are taught as gelling agents in the Roulier et al '814 reference.

Regarding claims 78 and 79, Roulier et al '814 sets forth the fatty phase as a further ingredient in concentrations of "up to 20% by weight". Said concentrations read on zero% by weight.

8. Claims 27-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 97/17055 to L'Oreal, as evidenced by patent family member document Roulier et al US 6,045,814 (hereafter Roulier et al '814) in view of with Intercos Italia S.p.A., EP 803 245 (hereafter Intercos '245). Roulier et al '814 and WO 97/17055 are characterized for their teachings in the above rejection combination. Said characterizations are herein incorporated by reference.

Roulier et al '814 differs in the concentration of said gelling agents in the solid gels and the combination of gelling agents taught in the prior art for said same purpose as gelling agents.

Intercos '245 (abstract; column 1, lines 21 et seq; and examples and claims) discloses a compact solid gel comprising a water, polysaccharides, humectants and a powder phase. Intercos '245 (column 1, lines 34-44) discloses the hydrophilic gelling overlapping those disclosed in Roulier et al '814 employed either singly or in combination including carageenan, agar, gellan, alginic acids and salts at (column 1, lines 27 and 28) a concentration of 0.3 to 4% by weight of the gels. Said concentrations read on the claimed concentration.

Art Unit: 1712

Intercos '245 (column 1, lines 45 et seq) teaches the compositions are advantageously thermoreversible and may further incorporate electrolyte salts, soaps, various excipients employed in cosmetics including various fillers and pigments.

These references are combinable because they teach cosmetic gels. It would have been obvious to one of ordinary skill in the art at the time of applicants' invention to employ gellan gum as an obvious exudates contemplated in the Roulier et al '814 compositions at concentrations of less than 20 % by weight to form the thermoreversible gels taught in the Intercos '245 reference.

It is generally prima facie obvious to use in combination two or more ingredients that have previously been used separately for the same purpose in order to form a third composition useful for that same purpose. In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069 (CCPA 1980); In re Pinten, 459 F.2d 1053, 173 USPQ 801 (CCPA 1972); In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971); In re Crockett, 279 F.2d 274, 126 USPQ 186 (CCPA 1960). As stated in Kerkhoven and Crockett, the idea of combining them flows logically from their having been individually taught in the prior art. In the instant case, both the cellulose derivatives and the gellan gums are taught as gelling agents in the Roulier et al '814 reference.


### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

Art Unit: 1712

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
**Daniel S. Metzmaier**  
**Primary Examiner**  
**Art Unit 1712**

DSM  
December 11, 2002